

# BEYER WEAVER & THOMAS, LLP

INTELLECTUAL PROPERTY LAW  
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## FACSIMILE COVER SHEET

April 20, 2001

**Receiver:** Tina Plunkett

FAX RECEIVED

**TEL #:** 703-305-3524

APR 25 2001

**FAX #:** 703-308-4556

GROUP 1600

**Sender:** Leslie Russell

**Re:** Response to Restriction Requirement filed 9/28/00  
Serial No.: 09/311,890  
Our Docket No.: CYTOP008

Pages Including Cover Sheet(s): 6

### MESSAGE:

Tina,

Please let me know right away that this case is not abandoned. Please let me know if you need anything else.  
Thank you,

Leslie Russell

### CONFIDENTIALITY NOTE

The information contained in this facsimile (FAX) message is legally privileged and confidential information intended only for the use of the receiver or firm named above. If the reader of this message is not the intended receiver, you are hereby notified that any dissemination, distribution or copy of this FAX is strictly prohibited. If you have received this FAX in error, please immediately notify the sender at the telephone number provided above and return the original message to the sender at the address above via the United States Postal Service. Thank you.

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re application of: Sabry et al.

Attorney Docket No.: CYTOP008

Application No.: 09/311,890

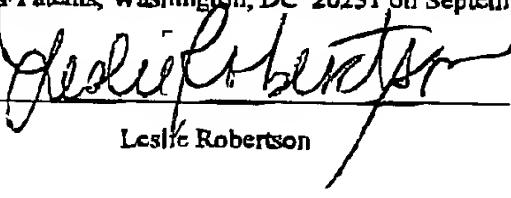
Examiner: Ogihara, N.

Filed: May 14, 1999

Group: 1631

Title: DATABASE SYSTEM FOR PREDICTIVE  
CELLULAR BIOINFORMATICS**CERTIFICATE OF MAILING**

I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail to: Assistant Commissioner for Patents, Washington, DC 20231 on September 28, 2000.

Signed: 

Leslie Robertson

**TRANSMITTAL**Assistant Commissioner for Patents  
Washington, DC 20231

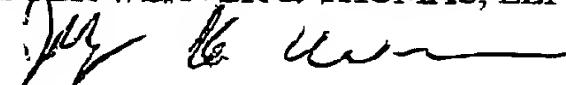
Sir:

Transmitted herewith for the above-identified application, please find:

## 1. Restriction Requirement.

Applicant(s) believe that no (additional) Extension of Time is required; however, if it is determined that such an extension is required, Applicant(s) hereby petition that such an extension be granted and authorize the Commissioner to charge the required fees for an Extension of Time under 37 CFR 1.136 to Deposit Account No. 50-0388.

Please additional fees required to facilitate filing the enclosed response, to Deposit Account No. 50-0388 (Order No. CYTOP008). A copy of this sheet is enclosed.

Respectfully submitted,  
BEYER WEAVER & THOMAS, LLP  
Jeffrey K. Weaver  
Reg. No. 37,260P.O. Box 778  
Berkeley, CA 94704-0778  
(510) 843-6200

FAX RECEIVED

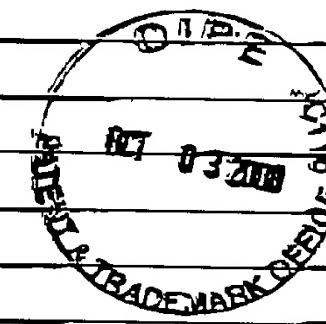
APR 25 2001

GROUP 1600

Docket #	CYTOP008	By:	JKW/lr	Date of this mailing:	<u>September 28, 2000</u>
Appl'n #:	09/311,890	Filing Date:	May 14, 1999		
Inv(s)	Sabry et al.				
Title:	DATABASE SYSTEM FOR PREDICTIVE CELLULAR BIOINFORMATICS				

The following have been received in the U.S. Patent Office on the date stamped hereon:

Item	Description	# Pgs
1.	Restriction Requirement Transmittal	1
2.	Restriction Requirement	2
3.	First Class Certificate of Mailing	
4.		
5.		
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7.		
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JKW/JCW

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## BEYER WEAVER &amp; THOMAS, LLP

INTELLECTUAL PROPERTY LAW

P.O. BEYER #178  
Berkeley, CA 94704-1778

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Docket's

Docket #	CYTOPO08	By:	MKW	Date of this mailing:	September 28, 2000
Appl'n #:	09/311,890	Filing Date:	May 4, 1999		
Inv(s)	Sabry et al.				
Title:	DATABASE SYSTEM FOR PREDICTIVE CELLULAR BIOINFORMATICS				

The following have been received in the U.S. Patent Office on the date stamped hereon:

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**PATENT****IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re application of: Sabry et al.

Attorney Docket No.: CYTOP008

Application No.: 09/311,890

Examiner: Ogihara, N.

Filed: May 14, 1999

Group: 1631

Title: DATABASE SYSTEM FOR PREDICTIVE  
CELLULAR BIOINFO#14  
Plunkett  
S(3)(0)**CERTIFICATE OF MAILING**

I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail to: Assistant Commissioner for Patents, Washington, DC 20231 on September 28, 2000.

Signed:

Leslie Robertson

**RESPONSE TO RESTRICTION REQUIREMENT**

Commissioner of Patents and Trademarks  
Washington, DC 20231

Dear Sir:

In response to the Restriction Requirement mailed September 1, 2000, having a period for response extending to October 1, 2000, Applicants provisionally elect claims 16-18 (group III) with traverse.

In order for a Restriction Requirement to be proper, the claim groups identified for restriction must be independent or distinct from one another. In addition, examining all claim groups in a single application and must present a serious burden on the Examiner. See MPEP § 803.

In the Restriction Requirement at issue, the Examiner acknowledges that each group of claims is classified in class 702, subclass 19. No other subclasses are mentioned. Therefore, it would seem that searching the separate groups of claims together would not present a serious burden..

All pending claims are directed to "systems." The Examiner argues that the various claim groups are distinct because "they are each drawn to differing methods with differing objectives, method steps, and outcomes." The claim elements represent various "system" features, not method steps. While the "objectives" of each claim group may be subtly different,

they are on balance quite similar. In at least the first three groups of claims, the recited systems each require some form of image acquisition system arranged to capture images of cells, together with a database system adapted to retrieve cell images or features or information about such images. The fourth claim group similarly requires a database which stores features obtain from an image processing device.

Each of the independent claims, defining a separate claim group, could be written with the same preamble. Specifically, each claim pertains to a "system" for acquiring and/or analyzing cellular information from images. If the examiner believes that an Amendment making the preambles consistent across all claim groups would overcome the Restriction Requirement, Applicants would make such Amendment.

On August 25, 2000, Applicants filed a Preliminary Amendment introducing new claims 29-44. These claims pertain to systems and methods for capturing and analyzing images of cells. As with all pending claims subject to the Restriction Requirement, these new claims also specify image capturing devices and components for analyzing and characterizing images of cells. For this reason, the new claims should be classified with the claims of groups I-IV. It is respectfully submitted that the new claims should not be subject to a separate Restriction Requirement.

Applicants believe that all pending claims are allowable and respectfully request a Notice of Allowance for this application from the Examiner. Should the Examiner believe that a telephone conference would expedite the prosecution of this application, the undersigned can be reached at the telephone number set out below. If any fees are due in connection with the filing this Response to Restriction Requirement, the Commissioner is hereby authorized to charge such fees to Deposit Account 05-0388 (Order No. CYTOP008).

Respectfully submitted,  
BEYER WEAVER & THOMAS, LLP



Jeffrey K. Weaver  
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